

Appln. No. 10/804,448

Attorney Docket No. 10541-1942

II. Remarks

Reconsideration and re-examination of this application in view of the above amendments and the following remarks is herein respectfully requested.

Claims 1-28 remain pending.

Claim Rejections – 35 U.S.C. §103

Claims 1-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over European Patent 1388653 (Cornaglia) in view of Japanese Publication 03-107522 to Nakachi (Nakachi).

The Examiner contends that Cornaglia and JP '522 together teach the elements of claims 1, 10 and 19. However, Applicants suggest that a *prima facie* case for obviousness has not been established by the examiner. "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP §2142. The examiner has not provided factual support that the subject matter of claims 1, 10, and 19 would have been obvious at the time of the invention to a person of ordinary skill in the art. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte*, Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

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Nothing in JP '522 teaches or suggests a moveable member that can provide a precise adjustment of the volume of the resonator. JP '522 deals with three independent resonators, each with fixed volumes, and does not contemplate switching between two variable volumes. Cornaglia teaches a variable volume resonator, however, nothing in Cornaglia teaches or suggests using valves to open or close the volumes. As such, Cornaglia does not recognize the need or desire to quickly adjust for sudden changes in frequency, due to shifts in the vehicle transmission, that cannot be addressed by a screw driven member. Accordingly, Cornaglia and JP '522 are independent references and nothing in either reference provides factual support for the combination thereof. It is therefore submitted that, the combination as provided by the examiner is improper and should be withdrawn.

Claims 2-9, 11-18, and 20-28 depend from claims 1, 10, or 19, and are, therefore, patentable for at the least the same reasons as given above in support of claims 1, 10, and 19. In particular, Applicants would further identify claims 11 and 14 where it is recited that the moveable member is controlled in conjunction with the valves to address a shift in engine rpm. Neither reference teaches both a moveable member and valves. Further, the coordinated interaction between the moveable member and valves based on engine rpm depends on the configuration of both structures and, therefore, cannot be taught or suggested by the references as the examiner contends. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.



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Conclusion

In view of the above amendments and remarks, it is respectfully submitted that the present form of the claims are patentably distinguishable over the art of record and that this application is now in condition for allowance. Such action is respectfully requested.

Respectfully submitted by,

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